

REMARKS

Claims 61, 64, 66, 68, 81-88 are pending in the application and are rejected in this Office Action.

Rejections Under 35 U.S.C. §103

The Examiner rejects claims 61, 64, 66, 68, 83, 85 and 87 under 35 U.S.C. §103(a) as being unpatentable over Strella et al. US 3,928,656 (the '656 patent) of record in view of Ohno 5,854,365 (the '365 patent) of record in view of Perronin et al. US 3,991,007 (the '007 patent) of record as evidenced by US 5,798,426 (of record).

The Examiner indicates that Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment-0.8%) (see example 1 and preparation of toner, column 9; see instant claim 61, 64 and 66). The ionic polymer disclosed is butyl methacrylate-acrylic copolymer (94.2/5.8) with a TG of 46 degrees Celsius (see examples II and VIII; see instant claim 61). The Examiner indicated that Strella teaches the use of a pigment or dye such as carbon black, a commercial red, blue, or yellow dye, or any other well-known pigment in an amount of 1-20% (see column 6, lines 4-16); see instant claim 87).

The Examiner indicates that although Strella teaches pigments in the composition, the instant pigments are not specified and that the instant solvents and the inclusion of nitrocellulose are not taught.

The Examiner uses Ohno indicating that Ohno teaches a toner composition wherein the pigment may be carbon black, an aniline black, acetylene black, naphthol yellow, Hansa yellow, rhodamine lake, alizarin lake, iron oxide red, phthalocyanine blue and indanthrene blue in the amount of 0.1-20% (see column 22, lines 25-40; see instant claim 61 and 87).

The Examiner indicates Perronin teaches the preparation of pigmentary particles coated with an organic polymer to allow dispersion of the pigment in a medium. Perronin discusses the importance of pigments in many fields such textiles, plastics, inks, textiles, and cosmetics (see column 1, lines 10-12), the pigment compositions may be advantageously used in numerous

fields of application, such as inks, plastics materials, paints, or other colored preparations (see column 4, lines 45-55), examples of monomers which may be used in the process include 1) alkene-mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc.(see column 3, lines 40-60; see instant claim 61),the pigments used in the composition may be iron oxides and titanium dioxide (see column 2, line 65 to column 3, line 5; see instant claim 61). The solvents may be selected from gasolines, aromatic hydrocarbons such as benzene, toluene, xylene, halogenated hydrocarbons such as trichloroethylene, perchloroethylene, chlorobenzene, trichlorobenzene, chlorofluoromethanes, chlorofluoroethanes, alcohols such as methanol, ethanol, n-propanol, 1-methyl-ethanol, n-butanol, 2 methyl-propanol, 1,1-dimethyl-ethanol, ketones such as 2-propanone, 2-butanone, 4-methyl-2-pentanone, esters such as ethyl acetate, propyl acetate, 1-methyl-ethyl acetate, ethers such as diethyl ether, ethylpropyl ether, tetrahydrofuran, and 1,4-dioxan (see column 2, lines 45-61; see instant claim).

To rely on a reference under 35 U.S.C. 103, the reference must be analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir.1992)." Manual of Patent Examining Procedure 2141.01 (a) analogous and Nonanalogous Art [R-3], 2100-119, Rev.5,Aug.2006.

The subject application's US class is 424, drugs, bio-affecting and body treating compositions. The '365 patent US class is 526, synthetic resins. The '007 patent US class is chemistry of carbon compounds. The '656 patent US class is 427, coating process. The patent office classifications evidence completely different technology supporting the fact that the art cited by the Examiner is nonanalogous to the subject matter of this application.

Further support for nonanalogy is in the structure and function of the subject application and the art cited by the Examiner. The current application is directed to a formulation that is used in treating humans while the '365, '007, and '656 patents are formulations that are used in printer technology. A composition that is safe for use on humans can not have an analogous function or application to a composition that is not designed or proven safe for application on humans. The Manual of Patent Examining Procedure requires art to be analogous to the subject matter claimed and this is not the case with the art cited by the Examiner.

The Manual of Patent Examining Procedure 2141.01 (a) analogous and Nonanalogous Art [R-3], III. Analogy in the Chemical Arts, 2100-119, Rev. 5, Aug. 2006, requires "the teachings in each of the various references would have been pertinent to the problems in the other references and the invention at hand."

On page 2, lines 1-9 of this specification the problems in the field which this application resolves are set forth. The subject matter of this application provides a polymer-based nail enamel composition which provides good wear, adhesion, and gloss, contains significantly reduced levels of cellulose-based film formers, and exhibits reduced yellowing of the nails.

The problems in the field which the '656 patent resolves are set forth in column 1, lines 49 – 60. The object of the '656 patent is to provide an improved electrostatographic developer and a toner which is capable of being fixed to a support surface by the application of pressure.

The problems in the field which the '365 patent resolves are set forth in columns 3, line 65 – column 4, line 5. The '365 patent provides a toner which exhibits (i) a considerably wide temperature range in which fixing can be performed, (ii) excellent reproducibility of fine lines and (iii) performance capable of forming stable images having excellent image quality.

The problems in the field which the '007 patent resolves are set forth in column 1, lines 1 – column 2, lines 24. The '007 patent resolves a process for the preparation of pigmentary particles coated with organic polymer by polymerization or copolymerization reaction carried out in at least one organic solvent, polymerization catalyst, and a soluble monomer.

Clearly, the '656 patent, the '365 patent, and the '007 patent do nothing to resolve the problems of good wear, adhesion, gloss, reduced yellowing with reduced levels of cellulose-based film formers in pigmented nail enamel applied to human nails. The prior art cited by the Examiner are not pertinent to the problems resolved in the subject application and do not serve as prior art as set forth in the Manual of Patent Examining Procedure and case law cited therein.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Manual of Patent Examining Procedure 2141.02, 2100-121 -122, Rev. 5, Aug. 2006.

In determining obviousness under 35 U.S.C. 103 the four factual inquiries are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l Cp. v. Teleflex Inc.*, No 04-1350 (US Apr. 30, 2007).

The '656 patent discloses a formula comprised of crosslinked polymer which comprises from about 80% to about 100%, preferably from about 90% to 100%, of the resinous portion of the toner (column 6, lines 51 – 53). The crosslink bond strength and glass transition temperature of the toner polymer is selected within specified ranges to provide a polymer having a yield stress sufficiently low to permit yielding by application of pressure (column 2, lines 45 – 48).

The Examiner cites Example 1 as having an ionic polymer, butyl methacrylate-acrylic copolymer. This is incorrect. The ionic polymer in Example 1 is styrene-n-butyl methacrylate (column 9, line 8). The ionic polymer of Example II is a product of N-butyl methacrylate, acrylic acid and azo-bis, not butyl methacrylate-acrylic copolymer.

In citing the '656 patent against the subject claims the Examiner has selected a recitation of one component of the crosslinked polymer. The Examiner ignores the teaching in the '656 patent that there is a necessity of a specific glass transition temperature achieved by attaching charged groups pendant to the polymer backbone (column 3 , lines 55 -62) to resolve the problem of providing an improved electrostatographic developer and a toner which is capable of being fixed to a support surface by the application of pressure.

The amount of ionic crosslinking affects the glass transition temperature (column 4, line 35-40). The monomers which are used in producing the weakly cross-linked polymers of the present invention, and in particular the ionic polymers, may be homopolymerized or

copolymerized to provide a polymer having the required glass transition temperature (column 4, lines 46 – 50). The toner hereinabove described is affixed by electrostatic attraction (column 6, line 61 – column 7, line 13).

In ignoring the invention of the '656 patent as a whole the Examiner fails to see that the composition in the '656 patent is not a composition suitable for application on human nails (due to the charged groups pendant on the polymer backbone) or that the composition can be fixed to a support without application of pressure or an electrostatographic charge.

Because the polymer in the '656 patent is a backbone for the whole composition it is not the same as the copolymer without pendant groups in the subject application and therefore has different performance characteristics from the composition of the subject claims.

The Examiner has cited the '365 and '007 references because they use pigments.

The '365 patent does not have polymers of the subject application (crosslinking monomers are defined in column 8, lines 22 – 52 of the '365 patent). The polymer of the '365 is a high molecular weight polymer. In order to solve the problem, i.e. providing a toner which exhibits (i) a considerably wide temperature range in which fixing can be performed, (ii) excellent reproducibility of fine lines and (iii) performance capable of forming stable images having excellent image quality, the polymer is combined with a low molecular weight wax to form a resin (column 8, lines 61 – 67).

Neither Applicant's claimed composition nor the composition in the '656 patent contain a wax combined with a polymer as disclosed in the '365 patent.

The coloring agent used in the toner of the '365 patent is exemplified by an arbitrary pigment or dye (column 22, line 26 – 27).

The standard for a 35 USC 103 rejection is consideration of inventions as a whole and to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

The Examiner fails to provide an apparent reason why the addition of arbitrary pigments or dyes in the '365 patent to applicant's nail enamel composition would be recognized by a person having ordinary skill in the art and used by that person to combine the known elements in the fashion claimed by the patent at issue, but that is what is required.

The Examiner cites '007 which disclose pigments coated by a polymer. None of the cited art ('656 patent or the '365 patent) or applicant's claims uses or discusses coated pigments.

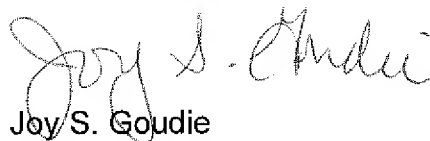
As discussed in the '007 patent, pigments are coated with a solid layer isolating them from one another and thus preventing reagglomeration (column 1, lines 26 – 29). The reason pigments reagglomerate rather than dissolving is that they are added to a medium where they are insoluble (column 1, lines 10 – 12).

Since the pigments in Applicant's application as well as the '656 patent and the '365 patent dissolve in the compositions disclosed it is not clear why one of ordinary skill in the art would consider the '007 as interrelated at all. The Examiner has not given any apparent reason to combine the known elements of the '007 patent in the fashion claimed by the patent at issue.

In view of the above amendments and remarks, Applicants request withdrawal of the 103 rejection and respectfully submit that this application is now in condition for allowance and earnestly request such action.

If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,



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